

Remarks

Claims 12-20 are pending. Claim 12 is rejected under 35 U.S.C. § 102(b) as being anticipated by Sawa (5,228,190). Claims 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawa in view of Kurosawa et al. (4,748,837). Claims 16-20 are allowed.

For a rejection to be proper under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

The Examiner states that “Sawa discloses: ... providing a one-piece panel having a first portion formed as a[n] ... outer panel (Wo) and a second portion formed as a[n] ... inner panel (Wi) (col. 1, lines 7 and 8; col. 3, lines 41-50).” Turning to the text cited by the Examiner, column 1, lines 7 and 8, of Sawa merely recites that the “present invention relates to a roller type hemming apparatus for hemming, for example, of a door panel for a vehicle.” Further, column 3, lines 41-44 of Sawa discloses that the “outer panel Wo and the inner panel Wi are placed on a lower die 5 with the stepped portion of the inner panel Wi arranged along the inside of the bent portion of the outer panel Wo.” Neither of these sections of Sawa teach that a one-piece panel has “a first portion formed as a[n] ... outer panel and a second portion formed as a[n] ... inner panel,” as recited by claim 12.

Sawa further states, at column 3, lines 36-37, that “[t]he workpiece W is, for example, a door panel composed of an outer panel Wo and an inner panel Wi.” Sawa does not *expressly* teach that the door panel W is a one-piece panel, and that the outer panel Wo is a “first portion” of the one-piece panel and the inner panel Wi is a “second portion” of the one-piece panel, as recited by claim 12.

Those skilled in the art will recognize that the door panel of Sawa is not “one-piece,” but is rather multiple pieces operatively connected together, and that it is apparent from Applicants’ disclosure that a “unitary, one-piece panel ... having an outer panel portion and an inner panel portion” does not encompass separate inner panels and outer panels operatively connected to one another.

Furthermore, in *W.E. Hall Co., Inc. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 17 U.S.P.Q.2d 1135 (Fed. Cir. 2004), the Court of Appeals for the Federal Circuit discussed the meaning of “single piece” as used in a patent claim when affirming a district court holding of noninfringement. Hall filed an action against Atlanta in district court for infringement of a patent reciting a pipe having a “single piece construction” in claim 1. Atlanta’s pipe included metal inserts within ribs along the pipe, but was otherwise materially the same. Nevertheless, the district court held that the pipe plus the inserts constituted “multiple pieces,” and “had difficulty understanding how a ‘single piece construction’ might include multiple pieces.” *Id.* at 1349. (emphasis added). Accordingly, the district court granted Atlanta’s motion for summary judgment, “explaining that because Atlanta’s pipe was not of single piece construction, there was no issue of material fact as to infringement.” *Id.* at 1349.

The Federal Circuit affirmed the district court’s decision, stating:

We therefore rely on the plain and ordinary meaning of the terms. The disputed terms are straightforward ‘Single piece’ is sufficiently clear to make even resort to the dictionary unnecessary. ... The district court was therefore correct in its construction of the claims. *Id.*, at 1350. (emphasis added).

Like the Federal Circuit, Applicants have difficulty understanding how a “one-piece panel” could include multiple pieces. Applicants have included nothing in the specification or the prosecution history to indicate the use of the term “one-piece panel” was intended to mean anything other than its plain and ordinary meaning, and indeed Applicants’ specification clearly distinguishes between single piece construction and multiple piece

construction. While joining multiple pieces together, as taught by Sawa, may or may not result in a “unitary” panel, it clearly does not result in a “one-piece panel,” as recited by claim 12.

Claim 12 also recites “subsequent to said providing a one-piece panel, bending the panel to form a crease between the first portion and the second portion.” (emphasis added). The Examiner states that Sawa discloses “subsequent to the providing a unitary panel, bending the panel lo [sic] form a crease between the first portion and the second portion (col. 3, lines 41-50; Fig. 1).”

However, as shown in Figure 1 of Sawa, Sawa does not teach bending “a one-piece panel having a first portion formed as a[n] ... outer panel and a second portion formed as a[n] ... inner panel,” as recited by claim 12, but instead teaches only bending a peripheral portion of the outer panel. More specifically, as depicted in Figure 1 of Sawa, the hem roller 4 bends only the outer panel W_o , and does not bend a one-piece panel having a first portion formed as an outer panel and a second portion formed as an inner panel.

Accordingly, Sawa does not teach all of the elements and limitations of claim 12, and therefore the rejection of claim 12 under 35 U.S.C. § 102(b) is improper.

Moreover, claim 12 recites that the “first portion” of the one-piece panel is “formed as a vehicle body compartment lid outer panel” and that the “second portion” of the one-piece panel is formed as a vehicle body compartment lid inner panel.” Sawa teaches a “door panel,” and not a vehicle body compartment lid, such as a hood or a decklid.

Claims 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawa in view of Kurosawa et al. Claims 13-15 ultimately depend from claim 12, and therefore include all of the elements and limitations of claim 12. Since the Examiner relies on Sawa for the elements and limitations of claim 12 in the rejections of claims 13-15, the rejection of claims 13-15 is improper for at least the same reasons set forth *infra* with respect to claim 12.

Applicants note with appreciation the allowance of claims 16-20.

CONCLUSION

This Amendment is believed to be fully responsive to the Office Action mailed Oct. 22, 2006. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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